

II. REMARKS**A. Status of the Claims**

Claims 1-17, and 19-24 are currently pending. Claims 1, 6, 10-11, 16-17, 19-24 have been amended. It is respectfully submitted that no new matter has been added by virtue of the present amendment.

B. Objection to Claim 20 under 37 C.F.R. 1.75

In the Office Action, the Examiner objected to claim 20 under 37 C.F.R. 1.75 as being a substantial duplicate of claim 19. As claim 20 has been amended, the objection is now moot.

We note that although the pending claims have been amended, we nevertheless believe it would expedite prosecution to present arguments concerning patentability of the new claims over the cited references at the present time. Our arguments are therefore set forth below.

C. Rejection under 35 U.S.C. § 102

Claims 1-6, 11-12, 17, 19-22 were rejected under 35 U.S.C. § 102(b) as being anticipated by German reference 296 19 564, (hereafter "German reference '564.>").

German reference '564 is directed to a tableting tool which includes an embossing element with a coating that may comprise a variety of different compounds, including zirconia. It is noted that claim 1 has been revised to recite a "[a] part for use in a tableting machine comprising a shaped member **consisting of stabilized zirconia.**" (emphasis added). Support for stabilized zirconia is found in the present specification at page 7, lines 5-10, and page 13, lines 24-31. In contrast, German reference '564 fails to teach stabilized zirconia, as recited in claim 1. As German reference '564 fails to teach each and every element of claim 1, withdrawal of the Examiner's rejection of this claim is respectfully requested. As claims 2-6, 11-12, 17, 19-21 depend from claim 1, withdrawal of the Examiner's rejections of these claims is also respectfully requested.

Applicants also direct the Examiner's attention to claims 3 and 13, which recite as follows:

Claim 3. A part according to claim 2, in which the shaped member constitutes the **whole** punch.

Claim 13. A part according to claim 12, in which the shaped member constitutes the **whole** die.

As discussed above, German reference '564 is directed to a tableting tool which includes an embossing element that may comprise a variety of different compounds, including zirconia, but merely as a **coating**. In contrast, it is the **whole** die or **whole** punch which consists of the stabilized zirconia, as recited in claims 3 and 13 of the present application. Therefore, German reference '564 fails to teach a part of a tableting tool which is comprised **entirely** of stabilized zirconia, as recited in claims 3 and 13 of the present application. Accordingly, claims 3 and 13 are patentable over German reference '564 for this reason as well.

Claim 22 recites, in pertinent part, "[a] tableting machine which comprises . . . a shaped member consisting essentially of **stabilized** zirconia . . ." (Emphasis added). Like claim 1, claim 22 is limited to only stabilized zirconia. As German reference '564 fails to teach each and every element of claim 22, withdrawal of the Examiner's rejection is respectfully requested.

Claims 1, 12-15, 17 and 19-24 were rejected under 35 U.S.C. § 102(b) as being anticipated by Japanese reference 61-293410 (hereafter "the Japanese reference").

In response, claims 1, 17, 22 and 24 recite as follows:

Claim 1. A part for use in a **tableting machine**, the part comprising a shaped member consisting of stabilized zirconia.

Claim 17. A part for use in a **tableting machine**, the part comprising a shaped

member consisting of alumina and **from 5 to 20% by weight stabilized zirconia**.

Claim 22. A **tableting machine** which comprises at least one punch comprising a shaped member consisting essentially of stabilized zirconia and/or at least one die comprising a shaped member consisting essentially of stabilized zirconia.

Claim 24. A member consisting of stabilized zirconia, the member being suitable for use in an **apparatus for the manufacture of tablets**.

The Japanese reference teaches a mold for powder molding, for “molding a buffer layer and abrasive grain layer of a grinding wheel.” It does not teach a part in a **tableting machine**, as recited in claims 1 and 17. Nor does it teach a **tableting machine** as recited in claim 22 or a member for use in an **apparatus for the manufacture of tablets**, as recited in claim 24. It further fails to teach **from about 5 to 20% by weight of stabilized zirconia**, as recited in claim 17 of the present application. As the Japanese reference fails to teach each and every element of claims 1, 17, 22 and 24, withdrawal of the Examiner’s rejection is respectfully requested. As claims 12-15, and 19- 21 depend from claim 1, withdrawal of the Examiner’s rejection of these claims as anticipated is also respectfully requested. As claim 23 depends from claim 22, withdrawal of the Examiner’s rejection is also respectfully requested.

Claims 1-6, 12-15, 17 and 19-24 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,732,056 to Eddy et al. (hereafter “the Eddy patent”).

The Eddy patent is directed to an apparatus for hot pressing oxide ceramics in a controlled oxygen atmosphere, producing sintered oxide ceramics having improved electrical, magnetic and mechanical properties. (See Eddy Abstract). Although the Eddy patent discloses a mold cavity, it does so with respect to ceramic oxide powders, specifically ferromagnetic materials, ferromagnetic materials, ferroelectrics, dielectrics, piezoelectrics, resistive

semiconductive and electro-optic materials. (See Eddy column 1, lines 8-11). The Eddy patent bears absolutely no relation to tableting. As the Eddy patent fails to teach each and every element of claims 1, 17, 22 and 24, withdrawal of the Examiner's rejection of these claims as anticipated is respectfully requested. As claims 2-16 depend from claim 1, claims 19-21 depend from claim 17, and claim 23 depends from claim 22, the Examiner's rejection of these claims is also respectfully requested.

Claims 1, 12, and 14-16 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,162,118 to Niiler et al. (hereafter "the Niiler patent").

The Niiler patent teaches an apparatus for compaction of ceramic material, which includes the detonation of explosive material, "[a] layer of powdered high explosive is placed on top of the compression plate . . ." (See Niiler at column 5, lines 5-6). In sharp contrast, as discussed above, claim 1 recites, in pertinent part, "[a] part for use in a **tableting machine** . . ." Not only does the Niiler patent fail to teach, let alone mention a tableting machine, as recited in claim 1, the compaction of ceramic powders subjected to explosive detonation obviously bears no relation to the present invention. As the Niiler patent fails to teach each and every element of claim 1, withdrawal of the Examiner's rejection of claim 1 as anticipated is respectfully requested. As claims 12, and 14-16 depend from claim 1, withdrawal of the Examiner's rejection of these claims is also respectfully requested.

D. Rejection of claims 7-11 under 35 U.S.C. § 103(a)

Claims 7-11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Eddy patent as applied to claims 1-6, 12-15, 17 and 19-24 above, and further in view of second German reference 298 07 840 (hereafter "German reference '840").

The Examiner asserts that it would have been obvious to one of ordinary skill in the art to modify the Eddy patent by providing an embossing or recess on the mold surface as taught by

German reference '840. The Examiner apparently recognizes that German reference '840 does not discuss Zirconia. The Examiner additionally asserts that the limitations of claim 10 are within the scope of the skilled artisan. As established above, the Eddy patent not only fails to teach each and every element of claim 1, but bears no relation to the present invention, as it is directed to the compaction of ceramic oxide powders, making no mention of tableting or anything related to tableting. Furthermore, although German reference '840 is directed to a tableting tool, one of ordinary skill in the art would have absolutely no incentive to combine the teachings of the Eddy patent and German reference '840 as the oxide ceramics of the Eddy patent, having improved electrical or magnetic properties, bear no relation to tableting. Accordingly, withdrawal of the Examiner's rejection of claims 7-11 is respectfully requested.

III. CONCLUSION

In view of the amendments made and arguments presented, it is respectfully submitted that the present claims are now in condition for allowance.

An early and favorable action on the merits is earnestly solicited. The Examiner is respectfully requested to contact the undersigned in the event that a telephonic interview will advance the prosecution of this application.

Respectfully submitted,
DAVIDSON, DAVIDSON & KAPPEL, LLC

By: 

Cary S. Kappel
Reg. No. 36,561

Davidson, Davidson & Kappel, LLC
485 Seventh Avenue, 14th Floor
New York, New York 10018
(212) 736-1940